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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,303	01/23/2001	Patrice Martinez	P 07058US00	4453
881	7590	11/01/2004	EXAMINER	
STITES & HARBISON PLLC 1199 NORTH FAIRFAX STREET SUITE 900 ALEXANDRIA, VA 22314			PATEL, MITAL B	
			ART UNIT	PAPER NUMBER
			3743	
DATE MAILED: 11/01/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/744,303

Applicant(s)

MARTINEZ ET AL.

Examiner

Mital B. Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 9-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-14 and 16 is/are rejected.
- 7) ☒ Claim(s) 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment/Arguments***

1. Applicant's arguments filed 07/30/04 have been fully considered but they are not persuasive.
2. In response to Applicant's arguments that Aulgur does not teach a demand regulator, the Examiner directs Applicant's attention to Column 2, lines 32-33 of the Aulgur reference US 5,036,846.
3. In response to Applicant's remarks, it is noted that Applicant merely argues the definition of a demand regulator and as such, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claims 9-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Aulgur et al (US 5,036,846).

6. **As to claim 9**, Aulgur teaches a demand regulator comprising communication means (**See Col. 4, lines 45-68**) for feeding a tube **16** for connection to an inside of a breathing mask with a pressurized breathing gas from an inlet **68**; means **13** for supplying dilution air to the breathing gas; a breath-out valve **70** opening from the tube to atmosphere; a manually actuatable control member **30** having a normal position causing operation without over pressure in the tube above atmosphere and with air dilution, and an emergency position causing the tube to be fed with the breathing gas at an over pressure; and means (**See Col. 5, lines 31-45**) for preventing feed of over pressure gas to the tube so long as the mask is in storage.

7. **As to claim 10**, Aulgur teaches a demand regulator wherein the means for preventing over pressure gas feed to the tube comprise a valve **28** responsive to donning of the mask on the face or to a mechanical pressure of the mask against the face.

8. **As to claim 11**, Aulgur teaches a regulator wherein the communication means comprise a main valve **36** defining a control chamber **68** connected via a constriction to the admission and controlling communication between the inlet tube and the tube, and a pilot valve **52** which is actuated responsive to breathe-in suction in the tube and cooperates with a fixed seat **90** for communicating the control chamber with a chamber which communicates with the inlet via a constriction.

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9. **As to claim 12**, Aulgur teaches a regulator wherein the valve is placed between the chamber and the atmosphere.

10. **As to claim 13**, Aulgur teaches a regulator wherein the means for preventing operation are designed to cause high pressure feed when the manually actuatable control member is in the emergency position in response to a first intake breath causing a gas pressure in the tube to drop below ambient pressure.

11. **As to claim 14**, Aulgur teaches a regulator wherein the means for preventing operation are designed to cause the regulator to be fed in response to inflation of a pneumatic harness of a mask carrying the regulator.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 9 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Bertheau et al (US 5,690,102).

The applied reference has a common Assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

13. **As to claim 9**, Bertheau teaches a demand regulator comprising communication means **27** for feeding a tube **17** for connection to an inside of a breathing mask with a

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pressurized breathing gas from an inlet; means **16** for supplying dilution air to the breathing gas; a breath-out valve **29** opening from the tube to atmosphere; a manually actuatable control member **18** having a normal position causing operation without over pressure in the tube above atmosphere and with air dilution, and an emergency position causing the tube to be fed with the breathing gas at an over pressure; and means **28** for preventing feed of over pressure gas to the tube so long as the mask is in storage.

14. **As to claim 16**, Bertheau teaches a demand regulator wherein the means for preventing feed are designed to retain a selection member **36** in the normal position so long as the mask is in storage and to cause the selection member to move into the emergency position when the mask is extracted from the storage.

#### ***Allowable Subject Matter***

15. Claim 15 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mital B. Patel whose telephone number is 703-306-5444. The examiner can normally be reached on Monday-Friday (8:00 - 4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 703-308-0101. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mital B. Patel  
Examiner  
Art Unit 3743

mbp

Henry Bennett  
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